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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/800,233
Filing Date: March 11, 2004
Appellant(s): KHANTZIS, CARLOS A.

Mr. Thomas Rozsa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed Dec. 28, 2007 appealing from the Office action mailed July 3, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,557,060	Kawashima	12-1985
4,211,236	Krinsky	7-1980
4,768,295	ITO	9-1988
5,775,005	McClelland	7-1998

Official Notice - treating material with a fungicide

Official Notice - shoes have an outsole, midsole and insole

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 4,6,7,10,11,12,35,37,38,41,42,43 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4557060 (Kawashima).

Kawashima teaches a foot wearing item including an insole (1), a midsole and an outsole (see the figures and col. 2, lines 29-32) comprising a flexible and deformable material (foam insert 4; see col. 1, lines 61-64) fitted within a cavity in the front portion of the sole. Regarding the functional language, the foam insert 4 is placed underneath the areas of the foot that correspond to the toes and metatarso-phalangeal joint (see figure 4) and therefore will permit the toes to curl downward when walking. Moreover, even if the foam padding was substantially hard, it would still allow the toes to curl downward, this would be possible in most types of footwear.

3. Claims 10,12,13,41,43,44 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4211236 (Krinsky).

Krinsky teaches a foot wearing item including an insole (top layer 18 of cushion 10 is inherently an insole inasmuch as it is placed in the shoe and makes contact with the foot; see col. 3, lines 25-27) comprising a flexible and deformable material (flowable,

highly viscous material 34) aligned with the insole. The cushion is placed underneath all areas of the foot including the toes and metatarso-phalangeal joint (see figure 3) and therefore will permit the toes to curl downward when walking.

Regarding claim 12 and the like, see col. 1, line 13-15 wherein it refers the cushion can be used by athletes and therefore the cushion can inherently be used in athletic shoes.

Regarding claim 13 and the like, the cover 18 or 20 or second envelope 60 can all serve as a cover.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236.

Krinsky teaches a footwear item as claimed (see the rejection above) except for the viscous material being one of those claimed. Krinsky doesn't provide a list of different types of viscous material that can be used. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the viscous flowable material out of gel or the like, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of

its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 14 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236 in view of official notice

Krinsky teaches a footwear item as claimed (see the 102 rejection above for details) except for the flexible and deformable material treated with a fungicide. The examiner takes official notice that it is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide. Therefore, it would have been obvious to provide the flexible and deformable material of Krinsky with a fungicide, to prevent fungus.

7. Claims 1-6,8-14 and 32-37,39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236 in view of Official Notice.

Krinsky teaches a foot wearing item including a deformable padding (cushion 10 is placed in the shoe and makes contact with the foot; see col. 3, lines 25-27) comprising a flexible and deformable material (flowable, highly viscous material 34). The cushion is placed underneath all areas of the foot including the toes and metatarso-phalangeal joint (see figure 3) and therefore will permit the toes to curl downward when walking. Some of the claims only require the toes to flex or bend; such as claims 1,4,32,35 which is extremely broad with that aspect. Krinsky teaches the deformable padding placed in a shoe but doesn't teach the aspects of the shoe. The examiner takes official notice that it is old and conventional in the art to have a shoe which includes an outsole, a midsole and an insole. Therefore, it would be obvious to place

the deformable padding (cushion 10) of Krinsky in a shoe having an insole, a midsole and an outsole. The cushion is placed on top of the insole and therefore is aligned with the insole.

With regard to the deformable material be a gel or the like, Krinsky doesn't provide a list of different types of viscous material that can be used. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the viscous flowable material out of gel or the like, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 5 and the like, the cushion appears to have a thickness as claimed. To the extent that it does not, it would appear to be an obvious design choice to construct it with a thickness as claimed inasmuch as a number of different thicknesses appear to be suitable depending on the size of the wearer and the sport being played.

Regarding claim 6 and the like, an insole is naturally placed over the midsole and therefore is aligned with the midsole.

Regarding claim 12 and the like, see col. 1, line13-15 of Krinsky wherein it refers the cushion can be used by athletes and therefore the cushion can inherently be used in athletic shoes.

Regarding claims 2 and 13 and the like, the cover 18 is a cover and is capable of being stretched and therefore is a stretched material.

Regarding treating the padding with a fungicide, the examiner takes official notice that it is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide. Therefore, it would have been obvious to provide the deformable padding as taught above with a fungicide, to prevent fungus.

8. Claims 1 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima '060 in view of US 4768295 (Ito).

Kawashima teaches a footwear item as claimed (see the 102 rejection above for details) except for the deformable material being a gel. Ito teaches a cushioning member placed in a cavity of the sole filled with a gel. It would have been obvious to one of ordinary skill in the art to form the cushioning members of Kawashima to be a gel filled cushioning member, as taught by Ito, to facilitate absorbing the shock instantly, see col. 1, lines 11-17 of Ito.

9. Claims 5 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima.

Kawashima teaches a foot wearing item (see the details in the 102 rejection above) except for the thickness of the deformable padding. The padding appears to be of the depth as claimed, however the dimensions are not given. It would appear to be an obvious design choice to construct the padding with a thickness as claimed inasmuch as a number of different thicknesses appear to be suitable depending on the size of the wearer and the sport being played.

10. Claims 2,33 and 8,13,39,44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1,32 and 4,10,35,41, respectively above, and further in view of US 5775005 (McClelland).

McClelland teaches providing a sock lining 28 to cover the insole. It would have been obvious to provide the insole as taught above with a sock liner on top, as taught by McClelland, to provide additional comfort to the wearer. The sock liner is a conventional sock liner, which is inherently capable of being stretched, and therefore is a stretched material.

11. Claims 3,34 and 9,14,40,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references, as applied to claims 1,32 and 4,10,35,41, respectively above, and further in view of Official Notice.

The examiner takes official notice that it is old and conventional in the art to provide shoe pads, cushions, insole, etc. with a fungicide. Therefore, it would have been obvious to provide the deformable padding as taught above with a fungicide, to prevent fungus.

(10) Response to Arguments

Throughout the arguments, Appellant continually argues how the prior art and applicant's invention are totally different.

However, these arguments are moot inasmuch as Appellant "must present arguments pointing out the specific distinctions believed to render the **claims**...patentable over any applied references", 37 C.F.R. 1.111. Only these types of arguments are meaningful and will be addressed below. It is helpful that Appellant

shows the distinction between his invention and the prior art but these distinctions must be in the claims.

- a. Claims 4,6,7,10,11,12,35,37,38,41,42,43 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4557060 (Kawashima).

Appellant argues "that the toe cushion [of Kawashima] is not made of the same material as the body of the shoe insert, but is instead made of a deformable gel, which is a different material from the body of the sole", page 18, lines 6-8 of Appellant's Brief.

In response, the "deformable gel" is not claimed in these claims and therefore this is moot as noted above.

Appellant argues that the toe cushion of Kawashima provides cushioning at the heel and under the ball of the foot and not immediately under the toes of the foot only.

In response, the limitation "under the toes of the foot only" is not claimed and therefore is moot.

Appellant argues the cushioning elements of Kawashima design is for a totally different purpose than that of the present invention.

In response, the cushioning elements of Kawashima design may be for a different purpose but yet it has the structure as claimed and is inherently capable of permitting the function language as claimed and therefore the claims are anticipated.

Appellant argues that the foam insert 4 of Kawashima is not located in an area encompassing the toes of the wearer.

In response, the claims only call for "all five toes rest on the deformable padding". To this extent and from the figures shown which clearly shown the foam insert 4 in the

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forefoot section of the shoe, the foam insert would at least support all five toes of a typical wearer's foot. Moreover, if Appellant were to amend the claims as such the language Appellant is relying on is only functional language and the shoe structure of Kawashima is inherently capable of supporting all five toes of a typical user. The foam insert 4 of Kawashima extends well into the forefoot area of the sole and there is usually an open spacing between the end of the shoe and the tip of the toes so as to not cram the toes in the end of the shoe and/or to allow room for one's foot to grow.

Appellant reproduces the independent claim of Kawashima and argues "It is clear from a review of the independent claims, that all the claims of the present invention are not identically set forth in Kawashima", page 17, lines 18-19 of Appellant's Brief.

In response, it is not clear why Appellant is only comparing the claims of the prior art when it is the whole disclosure of the prior art which can be used.

b. Claims 10,12,13,41,43,44 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4211236 (Krinsky).

Appellant argues that the invention of Krinsky is for a completely different proposes and the sole of the present invention provides cushioning only under the toe section of the foot and not the entire sole as taught by Krinsky; see the bottom of page 22 of Appellant's Brief.

In response, the limitation "only under the toes of the foot only" is not claimed and therefore is moot. With respect to the cushion of Krinsky being for a different purpose, the orthopedic cushion of Krinsky may be for a different purpose but yet it has

the structure as claimed and is inherently capable of permitting the function language as claimed.

Appellant argues that the present invention is not a method to fit the cushion, but instead is a device to provide tactile stimulation to the pads of the toes.

In response, no such limitation is made in the present claims and therefore this argument is moot.

Appellant reproduces the independent claim of Krinsky and argues It is clear from a review of the independent claims, that all the claims of the present invention are not identically set forth in Krinsky, see page 21 to the top of page 24.

In response, it is not clear why Appellant is only comparing the claims of the prior art when it is the whole disclosure of the prior art which can be used.

As previously noted, throughout the arguments, Appellant continually argues how the prior art and applicant's invention are totally different. Appellant goes at great length to how features of Krinsky are not shown or taught by the present invention.

However, these arguments are moot inasmuch as Appellant "must present arguments pointing out the specific distinctions believed to render the **claims**...patentable over any applied references", 37 C.F.R. 1.111. Only these types of arguments will be addressed. It is helpful that applicant shows the distinction between his invention and the prior art but these distinctions must be in the claims.

c. Claims 11,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236.

Appellant argues that the gel material of Krinsky is highly viscous and therefore would not satisfy the limitations of these claims.

In response, claims 11 and 42 include a grouping of several materials and one of them being polyurethane gel and non-leaking semi-solid gel, and in the rejection above it has been noted that Krinsky doesn't provide a list of different types of viscous material that can be used. Nonetheless, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the viscous flowable material out of gel or the like, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. The gel of Krinsky is enclosed in a casing and therefore would be non-leaking.

As previously noted, throughout the arguments, Appellant continually argues how the prior art and applicant's invention are totally different. Appellant goes at great length to how features of Krinsky are not shown or taught by the present invention.

However, these arguments are moot inasmuch as Appellant "must present arguments pointing out the specific distinctions believed to render the **claims**...patentable over any applied references", 37 C.F.R. 1.111. Only these types of arguments will be addressed. It is helpful that applicant shows the distinction between his invention and the prior art but these distinctions must be in the claims.

d. Claims 14 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236 in view of official notice.

Appellant doesn't contest the official notice and therefore it is admitted prior art. Other remarks in the section of Appellant's Brief are moot inasmuch as they do not pertain to the official notice and/or pertain to arguments already addressed.

- e. Claims 1-6,8-14 and 32-37,39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krinsky '236 in view of Official Notice.

Appellant argues while the gel of Krinsky is flowable, highly viscous material, the gel is under the pressure of the entire body and cannot therefore be grippable, or graspable by the toes alone as the pressure will prevent localized movement under the pads of the toes.

To the contrary, if the gel material is highly viscous material, it therefore would be graspable and grippable inasmuch as when the wearer's bends their toes it would extend inward in the deformable padding. Moreover, the claims don't call for it to be grippable but instead call for the padding or the deformable gel "permits the toes to curl, flex, bend or grasp downward when a wearer of the shoe is walking". Therefore, only one of these functions have to be satisfied. This functional language is extremely broad inasmuch as toes in almost any shoe would be permitted to flex, bend, or grasp downward when a wearer of the shoe is walking. There is usually plenty of room in the toe areas of shoes to permit the wearer to bend or flex their toes when desired.

Appellant doesn't contest the official notice and therefore it is admitted prior art. Other remarks in the section of Appellant's Brief are moot inasmuch as they do not pertain to the official notice or to limitations found in the rejected claims.

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- f. Claims 1 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima '060 in view of US 4768295 (Ito).

In this section of Appellant's Brief, Appellant argues that there is no motivation to combine the reference.

In response clear motivation is provided in the rejection and repeated below.

Kawashima teaches a footwear item as claimed (see the 102 rejection above for details) except for the deformable material being a gel. Ito teaches a cushioning member placed in a cavity of the sole filled with a gel. It would have been obvious to one of ordinary skill in the art to form the cushioning members of Kawashima to be a gel filled cushioning member, as taught by Ito, to facilitate absorbing the shock instantly, see col. 1, lines 11-17 of Ito.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Ted Kavanaugh/
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